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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,365	09/26/2003	Chris Savarese	06196.P002	3038

7590 11/04/2008  
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EXAMINER
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D'AGOSTINO, PAUL ANTHONY

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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11/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/672,365	<b>Applicant(s)</b> SAVARESE ET AL.	
	<b>Examiner</b> Paul A. D'Agostino	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 128-141 and 147-152 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 128-141 and 147-152 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/2/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This responds to Applicant's Arguments/Remarks filed 09/02/2008. Claims 128-141 and 147-148 have been amended. Claims 1-127 and 142-146 stand cancelled. Claims 150-152 have been newly added. Claims 128-141 and 147-152 are now pending in this application.

#### ***Response to Amendment and Interview***

1. Examiner's concurs with Applicant's response on claim interpretation and also construes the claims to have tags that are active and passive.
2. This acknowledges Applicant's responses to the rejections under 35 USC §112, second paragraph, and concurs with the rationale or changes made by Applicant with respect to all issues with the exception of paragraph 15 (Office Action Page 7). In paragraph 15, based on Applicant's reply to the objection, Examiner believes Claim 149 should depend from 148 and not from 136. Thus, the rejections under 25 USC § 112, second paragraph, are withdrawn.
3. It should be noted that to advance prosecution, in lieu of issuing several claim objections resulting from discrepancies induced when Applicant amended the claims and inconsistencies which arose after the interview when trying to understand the claims in light of the agreements, Examiner has proposed fully rewritten claims for Applicant's consideration. Examiner reasonably believes the proposed claims are consistent with the agreements made during the interview to a) be consistent with

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preambles and claim content which means incorporating a shell into the claim when the preamble recites a golf ball, b) to provide a limitation of a solid and closed base for every instance where a void is recited, and c) in reviewing the responses to the 112 issues, Examiner changed the dependency of Claim 149 from 136 to 148.

4. Based on the final composition of the claims and an updated prior art search, Examiner now raises a provisional double patenting rejection with respect to co-pending application 10/672,600. Therefore this Office Action will be a second Non-Final Office Action.

#### ***Double Patenting***

5. Claims 128-141 and 147-152 as well as the proposed new claims are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/672,600 and over claims 1-5, 60-66, and 72 of copending Application No. 11/248,766. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applications concern findable golf balls comprising a ball material; a first tag which is attached to said ball material, said first tag having a first antenna which is coupled to a first electrical component, said first antenna being patterned as a first radial transmission line; a second tag which is attached to said ball material, said second tag having a second antenna which is coupled to a second electrical component, said second antenna being patterned as a second radial transmission line, which is arranged

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substantially orthogonally relative to said first radial transmission line; and an a filler material used in a void and surrounding the electrical component.

6. These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

7. The following claim is drafted by the examiner and considered to distinguish patentably over the art of record in this application, and presented to Applicant for consideration to replace Claims 128, 129, and 150:

(New) A golf ball, comprising:

a spherical object having an outer spherical surface and having a first void recessed below the outer spherical surface and a second void recessed below the outer spherical surface of said spherical object, the first void being located at a first pole of a first axis of the spherical object and the second void being located at a second pole of the first axis, wherein the first void and the second void are configured to receive at least one electronic component and wherein the first void has a first solid and closed base and the second void has a second solid and closed base;

at least one antenna attached to the outer spherical surface, the at least one antenna configured to transmit an RF signal and configured to be coupled to the at least one electronic component; and

a shell that encloses said spherical object.

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8. The following claim is drafted by the examiner and considered to distinguish patentably over the art of record in this application, and presented to Applicant for consideration to replace Claims 136 and 151.

(New) A golf ball, comprising:

a spherical object having a first void on an outer surface of said spherical object, wherein the base of the first void is solid and closed;

a first antenna configured to transmit an RF signal, the first antenna being disposed on the outer surface;

a first semiconductor having at least a portion disposed within said first void, the first semiconductor coupled to the first antenna;

an adhesive material between the spherical object a base of said first void and said first semiconductor, and wherein the first semiconductor has a first surface disposed adjacent to the base of the first void and coupled to the base by the adhesive material, and wherein the first semiconductor has a second surface which is parallel with the first surface, and wherein the second surface is adjacent to the outer surface of the spherical object at an upper end of the void which is adjacent to the outer surface; and

a shell that encloses said spherical object.

9. The following claim is drafted by the examiner and considered to distinguish patentably over the art of record in this application, and presented to Applicant for

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consideration to replace Claims 141 and 151.

(New) A golf ball as in claim 140 further comprising a second tag having a second semiconductor which is coupled to a second antenna wherein a second void has a second solid and closed base and wherein said first antenna is patterned as a first radial transmission line and said second antenna is patterned as a second radial transmission line which is substantially orthogonal to said first radial transmission line.

10. The following claim is drafted by the examiner and considered to distinguish patentably over the art of record in this application, and presented to Applicant for consideration to replace Claims 148 and 152.

A golf ball component, comprising:

a spherical object having a first void on an outer surface of said spherical object, wherein the base of the first void is solid and closed;

a first antenna configured to transmit an RF signal, and disposed on the outer surface:

a first electrical component having at least a portion disposed within said first void, the first electrical component coupled to the first antenna; and

an adhesive material between the spherical object a base of said first void and said first electrical component and wherein the first electrical component has a first surface disposed adjacent to the base of the first void and coupled to the base by the

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adhesive material, and wherein the first electrical component has a second surface which is parallel with the first surface, and wherein the second surface is adjacent to the outer surface of the spherical object at an upper end of the void which is adjacent to the outer surface.

11. The following claim is drafted by the examiner and considered to distinguish patentably over the art of record in this application, and presented to Applicant for consideration to replace Claim 149.

(New) A golf ball component as in Claim 148 wherein said first electrical component includes at least one of a RFID circuitry, an integrated circuit, and a diode.

12. Claims 130-135, 137-141, and 147 are objected to as being dependent upon a rejected base claim, but would be allowable if Applicant concurs with Examiner's suggested new base claims above.

Note: Examiner upon allowance will reorder the claims starting with the broadest which appears to be formerly 148, then 136 and 128, and their dependent claims, respectively.

13. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not anticipate nor render obvious the claims proposed by Examiner. Specifically, it is not obvious for a findable golf ball or golf ball



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component to have an outer spherical surface having a void recessed below the outer spherical surface wherein the first void is configured to receive at least one electronic component and wherein the first void has a first solid and closed base, at least one antenna attached to the outer spherical surface, the at least one antenna configured to transmit an RF signal and configured to be coupled to the at least one electronic component; and a shell that encloses said spherical object in the case that a golf ball is claimed. The art of record demonstrates electronics that reach deep into the center of the ball for better survivability and impact resistance. The claimed invention mainly resides on the spherical surface of the inside of the golf ball.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/  
Supervisory Patent Examiner, Art Unit 3714

/Paul A. D'Agostino/  
Examiner, Art Unit 3714